

REMARKS

In light of the following remarks and above amendments, reconsideration and allowance of this application are respectfully requested.

It is submitted that these claims, as originally presented, are patentably distinct over the prior art cited by the Examiner, and that these claims were in full compliance with the requirements of 35 USC §112. Changes to these claims, as presented herein, are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

Claims 2-21, 23, 25, 27-29, 31, 33, 35, 36 and 39 and amended claims 1, 22, 24, 26, 30, 32, 34, 37 and 38 are in this application.

At paragraph 3 of the outstanding Final Office Action of February 27, 2004, the Examiner rejected claims 1, 3, 4, 7-10, 22, 24, 26, 28, 30 and 32 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Specifically, the Examiner stated that claims 1, 22, 24, 26, 30 and 32 recite the phrase "or the like" which renders the claims indefinite. The phrase "or the like" has been removed from all the claims. Applicants therefore respectfully request that the 112, second paragraph rejection to claims 1, 3, 4, 7-10, 22, 24, 26, 28, 30 and 32 be withdrawn.

At paragraph 5 of the outstanding Final Office Action of February 27, 2004, the Examiner rejected claims 34, 37 and 38 under 35 U.S.C. § 102(b) as being anticipated by Rao et al. (U.S. Patent No. 5,790,704). Applicants respectfully traverse the rejection.

Amended independent claim 34, recites in part, "An encoding apparatus, comprising... **a transmission signal generating portion for adding a synchronous signal that includes at least either a horizontal synchronous signal, a vertical synchronous signal, or a sequential synchronous signal**..." (Underlining and Bold added for emphasis.)

It is respectfully submitted that Rao does not teach the above-recited feature of amended independent claim 34.

At pages 6 and 13 of the present Final Office Action, the Examiner admitted that Rao does not teach a transmission signal generating portion for adding a synchronous signal that includes at least either a horizontal synchronous signal, a vertical synchronous signal, or a sequential synchronous signal. Therefore amended independent claim 34 is believed to be distinguishable over Rao for at least the reasons described above.

For reasons similar to those described above with regard to amended independent claim 34, amended independent claims 37 and 38 are also believed to be distinguishable from Rao.

Applicants therefore respectfully request the rejection of claims 34, 37 and 38 under 35 U.S.C. § 102(b) be withdrawn.

At paragraph 7 of the outstanding Final Office Action of February 27, 2004, the Examiner rejected claims 1, 3, 4, 7-10, 22, 24, 26, 28, 30 and 32 under 35 U.S.C. § 103(a) as being unpatenable over Rao et al. (U.S. Patent No. 5,790,704) in view of Kikuchi (U.S. Patent No. 5,828,326). Applicants respectfully traverse the rejection.

It is submitted that the Kikuchi patent reference cannot be used as prior art to reject the claims of the present invention. The Kikuchi patent and the present application are assigned to a common assignee, Sony Corporation. The Kikuchi patent issued on October 27, 1998, which is several days after the priority date of the present application of October 6, 1998. Thus, the Examiner has relied upon Kikuchi in a rejection under 35 U.S.C. 103 through 35 U.S.C. 102(e).

Kikuchi is not prior art through 102(a) because the invention was not known or used by others in this country, or patented in a printed publication in this or a foreign country, before the invention thereof. Kikuchi issued on October 27, 1998, whereas the current filed application claims priority to October 6, 1998.

Kikuchi is not prior art through 102(b) because while Kikuchi was issued October 27, 1998, the present application has an effective U.S. filing date of October 6, 1999, the international filing date (see 35 U.S.C. §363). Because this date is less than one year after issuance of Kikuchi, 102(b) would not apply.

Under the provisions of 35 U.S.C. 103(c), as amended on November 29, 1999, subject matter developed by another person, which qualifies as prior art only under one of more of subsections (e), (f) and (g) of 35 U.S.C. 102, shall not preclude patentability under §103 where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Accordingly, in view of the above, because Kikuchi would only be available as prior art under 35 U.S.C. 102(e), the Kikuchi patent cannot be used as prior art in a rejection

under 35 U.S.C. 103(a); and thus applicants request that all the 103(a) rejections to claims 1, 3, 4, 7-10, 22, 24, 26, 28, 30 and 32.

At paragraph 8 of the outstanding Final Office Action of February 27, 2004, the Examiner stated that claims 2, 5, 6, 11-21, 23, 25, 27, 29, 31, 33, 35, 36 and 39 are allowed. Applicants wish to thank the Examiner for stating that these claims are allowed.

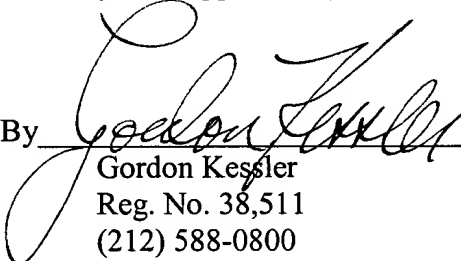
This is in response to the Examiner's Statement of Reasons for Allowance, which were included at pages 11-13 of the Final Office Action mailed February 27, 2004. To the extent the Examiner's Statement of Reasons for Allowance states, implies or is construed to mean that the claims are allowable over the prior art of record because the Examiner believes the claims should be interpreted to include one or more features or limitations not recited therein, Applicants attorney disagrees with such an interpretation. Moreover, it is Applicants contention that there is no particular limitation in the allowed claims that is more critical than any other. The issuance of the Examiner's Statement of Reasons for Allowance should not be construed as a surrender by Applicants of any subject matter. It is the intent of Applicants, by their attorney, to construe the allowed claims so as to cover the invention disclosed in the instant application and all equivalents to which the claimed invention is entitled.

The Examiner has made of record, but not applied, several U.S. patents. The Applicants appreciate the Examiner's explicit finding that these references, whether considered alone or in combination with others, do not render the claims of the present application unpatentable.

It is to be appreciated that the foregoing comments concerning the disclosures in the cited prior art represent the present opinions of the applicants undersigned attorney and, in the event, that the Examiner disagrees with any such opinions, it is requested that the Examiner indicate where in the reference, there is a basis for a contrary view.

Please charge any fees incurred by reason of this response and not paid herewith to Deposit Account No. 50-0320.

Respectfully submitted,
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